

## REMARKS

### *The Pending Claims*

The pending claims are directed to a chemical-mechanical polishing system comprising a liquid carrier, a polishing pad and/or an abrasive, a per-type oxidizer, and a phosphono additive having a specified chemical formula. Claims 1, 3-11, and 25-33 currently are pending.

### *Discussion of the Specification and Claim Amendments*

The specification has been amended to correct an obvious typographical error in the chemical nomenclature and to standardize the depiction of the chemical formulas. Claim 1 has been amended to recite that R<sup>1</sup> is a carboxyl group. This amendment is supported by the specification, for example, at pages 2-3, paragraph [0007], and page 4, paragraph [0014]. Claim 2 has been canceled in view of the amendment to claim 1, and claims 12-24 have been canceled, without prejudice or disclaimer of the subject matter recited therein, as being directed to a non-elected invention, in response to a restriction requirement. New claims 25-33 have been added to further characterize certain elements of the polishing composition of claims 9 and 11. These amendments are supported by the specification and the claims as originally filed. No new matter has been added by way of these amendments.

### *Summary of the Office Action*

The Office Action sets forth a two-way restriction requirement which identifies two allegedly distinct inventions. The Office Action further withdraws claims 12-24 from further consideration as being directed to a non-elected invention. The Office Action rejects claims 1, 2, 4-8, and 10 under 35 U.S.C. 102(b) as allegedly anticipated by U.S. Patent No. 5,783,489 (Kaufman et al.) (hereinafter "the Kaufman '489 patent").

### *Discussion of the Restriction Requirement*

As noted above, the Office Action repeats the two-way restriction requirement. In particular, the Office Action asserts that claims 1-11, which are directed to a chemical-mechanical polishing composition, define an invention that is distinct from that recited in claims 12-24, which are directed to a method of polishing a substrate. Applicant hereby affirms the election, without traverse, of the invention of claims 1-11 for further prosecution.

*Discussion of the Anticipation Rejection*

The Office Action rejects claims 1, 2, 4-8, and 10 as allegedly anticipated by the Kaufman '489 patent. In particular, the Office Action asserts that the Kaufman '489 patent discloses a polishing composition comprising a liquid carrier, an abrasive, a per-type oxidizer (i.e., hydrogen peroxide), and aminotri(methylenephosphonic) acid, which is a phosphono-containing compound falling within the general formula recited in the pending claims.

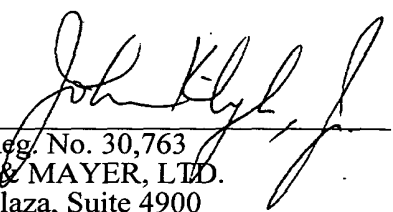
As noted above, the pending claims have been amended to recite that R<sup>1</sup> of the general formula for the additive is a carboxyl group. Aminotri(methylenephosphonic) acid does not comprise a carboxyl group and, thus, is not an additive falling within the general formula recited in the pending claims. Moreover, the Kaufman '489 patent does not disclose or suggest another suitable additive that falls within the formula recited in the pending claims. Indeed, the Kaufman '489 patent lists, in addition to aminotri(methylenephosphonic) acid, 1-hydroxyethylidene-4-diphosphonic acid, hexamethylenediaminetetramethylene phosphonic acid, and diethylenetetramine pentamethylenephosphonic acid as suitable stabilizers, none of which contains a carboxyl group, as recited in the pending claims.

In view of the foregoing, the subject matter defined by the pending claims is neither anticipated by nor rendered obvious over the Kaufman '489 patent. The rejection of the pending claims, therefore, should be withdrawn.

*Conclusion*

The application is considered in good and proper form for allowance, and the Examiner is respectfully requested to pass this application to issue. If, in the opinion of the Examiner, a telephone conference would expedite the prosecution of the subject application, the Examiner is invited to call the undersigned attorney.

Respectfully submitted,



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